

REMARKS

In response to the above-identified Office action, Applicant has amended claims 1-24, 39 and 41 as shown above and explained further herein below. No new matter has been entered by way of the amendments to the claims, as support for these amendments is found in the above-identified application as originally filed in claims 1-42; FIGS. 1 and 3-10; and at page 4, lines 18-27 and page 9, line 26 through page 15, line 26. Additionally, claims 43-55 have been withdrawn from consideration pursuant to a Restriction Requirement. As such, claims 1-55 remain pending in the above-identified application. Applicant requests reconsideration of claims 1-55 in view of the foregoing amendments and the following remarks.

SUMMARY OF THE SUBSTANCE OF A TELEPHONIC INTERVIEW

Applicant thanks the Office's representatives, Almari Yuan and William Bashore, for participating in the telephonic interview on October 14, 2004 with the undersigned to discuss the outstanding issues in this application. One of the issues discussed include Applicant's asserted improper combination of U.S. Patent No. 6,085,202 to Rao et al. and U.S. Patent No. 6,252,597 to Lokuge upon which the Office bases the outstanding 35 U.S.C. § 103(a) rejections of claims 1 and 23. The Office agreed to further consider whether the combination of Rao and Lokuge was improper.

The Office also suggested to the undersigned that a portion of the language in claims 1 and 23 directed to "one-dimensional entry lines" be amended to make the language clearer and to avoid any potential 35 U.S.C. § 112 rejections. The undersigned in turn agreed to consider amending claims 1 and 23 in a manner consistent with the Office's suggestion. After considering the Office's suggestion, Applicant has amended claims 1 and 23 as shown above in the interests of advancing prosecution. However,

Applicant submits that the prior language of “one-dimensional entry lines” is clear and definite.

Applicant respectfully directs the Office’s attention to the specification at page 8, lines 8–20, and to FIG. 3, of the above-identified application, which defines “lines 122,” shown in FIG. 3, as being “generally one-dimensional or narrow in that it has a vertical height or thickness insufficient to render text characters ...” As such, it is believed the prior language of “one-dimensional entry lines” that was recited in claims 1 and 23 clearly and definitely defined the subject matter being claimed. Furthermore, Applicant notes that these amendments make explicit what was implicit in the prior language of claims 1 and 23 relating to the “one-dimensional entry lines.” Therefore, these amendments were not made for reasons of patentability related to overcoming the outstanding § 103(a) rejection as applied by the Office to claims 1 and 23. In fact, Applicant reasserts its remarks with regard to the outstanding § 103(a) rejections being based on an improper combination of references as discussed more fully further herein below. As such, the scope and equivalents afforded to claims 1–42 should remain the same as they were prior to the amendments of claims 1 and 23.

Additionally, the Office noted during the interview that claims 1–22 appeared to be directed towards non-statutory subject matter and that these claims would likely be rejected under 35 U.S.C. § 101 in a subsequent Office action. However, the Office and the undersigned discussed several amendments that could be made to one or more of claims 1–22 to overcome the prospective § 101 rejections. As such, Applicant has amended claims 1–22 taking the Office’s observations into consideration as shown above and discussed further herein below.

Restriction Requirement

The Office issues a restriction requirement under 35 U.S.C. § 121 grouping claims 1–42 into an Invention I drawn to the visualization of threaded information entries, classifiable in U.S. Class 715, Subclass 526, and grouping claims 43–55 into an Invention II drawn to associating messages with identifiers, classifiable in U.S. Class 345, Subclasses 751 and 752. The Office asserts Inventions I and II are distinct from each other because they represent related sub-combinations that have at least one separate use apart from each other. The Office further asserts that separate searches need to be carried out for the claims grouped into Inventions I and II because of their different U.S. Class/Subclass classifications. As such, the Office asserts claims 1–42 have been constructively elected by original presentation for prosecution on the merits and has withdrawn claims 43–55 from consideration. Applicant respectfully traverses the restriction requirement for the following reasons.

Applicant submits that examining the claims from Inventions I and II together would impose no serious burden on the Office because separate searches for each group of claims may not be required. M.P.E.P. § 803 states, “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits.” The Office identified a single U.S. Classification for each of Inventions I and II (i.e., U.S. Classes 345 and 715) to show that each group of claims has acquired a separate status in the art thereby requiring a separate search. The following traversal thus addresses the single U.S. Classification examples provided by the Office in support of the Restriction Requirement.

Applicant respectfully submits that U.S. Class 345 is no more relevant for searching withdrawn claims 43–55 grouped in Invention II than it would be for searching constructively elected claims 1–42 grouped in Invention I. U.S. Class 345 is currently defined in the U.S. Manual of Patent Classification published on the Office's Website as relating to:

“... processes and apparatus for selective electrical control of two or more light-generating or light-controlling display elements in accordance with a received or stored image data signal. The image data includes character, graphical information or display attribute data. The image data may include, for example, information data from a peripheral input device, from the reception of a television signal, from the recognition of image data, or from the generation or creation of image data by a computer...”

Claim 43 from the withdrawn group of claims in Invention II recites, for example:

“43. A method for providing a threaded message representation, the method comprising:
 associating at least one message with at least one identifier that does not use at least one character-based representation for describing the at least one message; and
 presenting the at least one message using the at least one associated identifier in a threaded message format.”

The subject matter recited in independent claim 43 appears to be orthogonally related to the subject matter covered by U.S. Class 345.

Claim 1, as amended, from the constructively elected group of claims in Invention I recites, for example:

“1. A method for presenting threaded information entries as a graphical representation of threaded information rendered on a display interface, the method comprising:
 providing an indented threading arrangement on the display interface of substantially linear-shaped graphical representations of the threaded information entries.”

Similar to claim 43, the subject matter recited in claim 1 also appears to be orthogonally related to the subject matter covered by U.S. Class 345.

On the other hand, U.S. Class 715 appears to be related to subject matter that may be relevant for searching with respect to both of claims 1 and 43. U.S. Class 715 is currently defined in the U.S. Manual of Patent Classification as relating to:

“... Subject matter wherein the document is prepared for visual output. (1) Note. Processing of a document to enhance the visibility of particular elements through the addition of various attributes is classified herein.”

Still further, another portion of the definition provided for Class 715 in the U.S. Manual of Patent Classification notes:

“... SEE OR SEARCH CLASS:
345, Computer Graphics Processing and Selective Visual
Display Systems, subclasses 581 through 618 for display
attribute controllers.”

It would seem reasonable to search both of U.S. Classes 345 and 715 based on the suggestion noted above from the U.S. Manual of Patent Classification. As such, it is believed that no serious burden would be imposed on the Office by examining the claims together from the restricted groups corresponding to Inventions I and II. The Office is requested to reconsider and withdraw the outstanding Restriction Requirement, and examine claims 1–55 together, in view of the foregoing remarks.

Response to Rejections

The Office has rejected claims 1–22 under 35 U.S.C. § 101 asserting that the claims are directed to non-statutory subject matter because the claimed “information entries” are not embodied on a computer readable medium so as to cause a functional change in the computer. The Office also asserts that the claimed “arrangement” recited in claims 1–22 fail to define the structural and functional interrelationships between the claimed “information entries” and other claim elements. In response, Applicant has amended claims 1–22 to address the noted deficiencies. It is believed these claim

amendments overcome the § 101 rejection. Applicant notes that the amendments to claims 1-22 explicitly define structural and functional interrelationships that were implicit in the prior language of the claims and were not made for reasons of patentability relating to overcoming any prior art rejections. As such, the scope of claims 1-22 remains the same as it was prior to these amendments. In view of the foregoing amendments and remarks, the Office is respectfully requested to reconsider and withdraw the rejections of claims 1-23 under § 101.

The Office has rejected claims 1-3, 7-12, 14-26, 30-35 and 37-42 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,252,597 to Lokuge ("Lokuge") in view of U.S. Patent No. 6,085,202 to Rao et al. ("Rao"), and claims 4-6, 13, 27-29 and 36 under § 103(a) as being unpatentable over Lokuge in view of Rao and U.S. Patent No. 5,832,502 to Durham et al. The Office asserts that Lokuge discloses a threaded information visualization system that provides a visualization of threaded information that includes plural threaded information entries, a graphical representation of the threaded information rendered on a display screen (col. 2, line 6 through col. 3, line 14), comprising an indented threading arrangement (col. 6, lines 8-15; col. 11, lines 5-43; FIGS. 15 and 16). The Office concedes that Lokuge does not disclose generally one-dimensional entry lines that each represent one of the threaded information entries, but asserts that Rao teaches this limitation (col. 16, lines 33-37; col. 17, lines 46-54; FIGS. 14 and 15). The Office then asserts that it would have been obvious to combine Lokuge and Rao to render the above-identified claims obvious. Applicant hereby respectfully traverses the outstanding rejections for the following reasons.

The Office has not addressed Applicant's assertion that the invention disclosed in Lokuge cannot be modified by the teachings in Rao so as to render claims 1 and 23 obvious under § 103(a) because those proposed modifications would render the invention disclosed in Lokuge unsatisfactory for its intended purpose. If proposed modifications to an invention disclosed in a reference would render the reference's invention unsatisfactory for its intended purpose, then there is no motivation or suggestion to combine the reference's teachings with the teachings from which the proposed modifications are obtained. See M.P.E.P. § 2143.01.

As stated above, the Office must modify Lokuge to incorporate Rao's teachings because Lokuge fails to disclose or suggest generally one-dimensional entry lines that each represent one of the threaded information entries as conceded by the Office. However, Lokuge simply cannot be modified by any teaching that would require the invention disclosed in Lokuge to use anything other than textual or iconic representations that provide meaningful descriptions of underlying content because any such modifications would render the Lokuge invention unsatisfactory for its intended purpose.

The intended purpose of the Lokuge invention is to clearly display the contents of file categories that are of interest to a user while maintaining a display of the overall file structure, as discussed in Lokuge at col. 3, lines 27-30. In the background section at col. 2, lines 3-4, for example, Lokuge states that a "graphical user interface does not eliminate the need for a text-based structure." To clearly display the contents of file categories, Lokuge uses textual or iconic representations that are legible and/or recognizable to a user so that their underlying content can be identified and conveyed to

the user. Moreover, Lokuge does not consider or discuss representing the underlying content associated with file categories with non-textual or non-iconic representations.

Referring to Lokuge at FIG. 7 and col. 8, lines 17-35, for example, a computer display 40 is illustrated and described as having a companies category 60 that has been selected for display of its contents 62 that are of interest to a user. The contents 62 include pictorial icons 66 and text descriptors (e.g., aol, cisco, Fitch, Kenyan Systems). Unselected categories 56 (e.g., email, desktop, trash) may be resized to make room in the display 40 for the contents 62, as set forth in col. 8, lines 19-27. The pictorial icons 66 and text descriptors forming the contents 62 of the selected category 60 may also be resized when necessary to make room, as discussed at col. 8, lines 28-35. As shown in FIG. 7, however, the textual and iconic representations used to form the unselected categories 56, pictorial icons 66 and text descriptors remain legible and/or recognizable even if they are resized.

As mentioned above, the Office asserts that Lokuge discloses all of the limitations recited in claims 1 and 23 except generally one-dimensional entry lines that each represent one of the threaded information entries. The Office then asserts that Rao teaches generally one-dimensional entry lines that each represent one of the threaded information entries (col. 16, lines 33-37; col. 17, lines 46-54; FIGS. 14 and 15). The Office concludes that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Lokuge using the teachings from Rao to provide one-dimensional rows in a hierarchical arrangement on a graphical display to effectively view selected regions of interest in a graphical data representation environment.

Basically, Rao discloses using graphical display objects to represent non-textual data associated with a cell in a table. However, the textual and iconic representations used to form the unselected categories 56, pictorial icons 66 and text descriptors in Lokuge cannot be replaced with simple graphical representations because they must convey explicit information about their underlying content, such as a particular title (e.g., companies), for the invention to be satisfactory for its intended purpose. If simple graphical representations were used, then the Lokuge invention could not clearly display the file categories of interest to a user. Accordingly, there is no suggestion or motivation to modify Lokuge.

There must be some suggestion or motivation to modify a reference to establish a *prima facie* case of obviousness, as discussed in M.P.E.P. § 2143. The suggestion or motivation must be found either in the reference or in the knowledge generally available to one of ordinary skill in the art. As set forth above, there is no suggestion or motivation for modifying Lokuge found in either Lokuge or Rao, nor has the Office identified such a suggestion or motivation in either of the references.

Further, no evidence has been made of record in the above-identified application which shows that a suggestion or motivation for modifying Lokuge was found in the knowledge generally available to one of ordinary skill in the art at the time of the invention. As such, the burden now falls upon the Office to demonstrate that the suggestion or motivation for modifying Lokuge was found in the knowledge generally available to one of ordinary skill in the art at the time of the invention. Accordingly, Applicant respectfully requests evidence of such in a subsequent Office action.

Even if Lokuge could be modified to represent the unselected categories 56, pictorial icons 66 and text descriptors using simple graphical display objects without rendering the Lokuge invention unsatisfactory for its intended purpose, Rao does not teach representing threaded content or messages using graphical display objects. The Office's attention is now directed to Rao at FIG. 1 and col. 14, lines 11-26 and lines 47-53, which disclose using graphical display objects (e.g., black-filled bar 30, small rectangular black-filled object 32, color-filled bar 36, color-filled square 40, and black or white-filled square 42) for representing non-textual data associated with cells in a table 10. For example, the length of the black-filled bars 30 in column 1 of the table 10 may represent numeric data, such as a quantity value, as discussed at col. 15, lines 1-22 in connection with Table 2. However, the values represented by the graphical display objects employed by Rao are simple data values (e.g., numeric, Boolean, etc.), as discussed at col. 15, lines 37-67 in connection with Table 3. Accordingly, the combined teachings of Lokuge and Rao would still fail to disclose all of the limitations recited in claims 1 and 23. In view of the foregoing remarks, the Office is respectfully requested to reconsider and withdraw the rejections of claims 1 and 23. Since claims 2-22 depend from and contain the limitations of claim 1 and claims 24-42 depend from and contain the limitations of claim 23, they are patentable in the same manner as claims 1 and 23, respectively.

In view of all the foregoing, it is submitted that this case is in condition for allowance and such allowance is earnestly solicited. In the event that there are any outstanding matters remaining in the above-identified application, the Office is invited to contact the undersigned to discuss this application.

Respectfully submitted,

MICROSOFT CORPORATION

Date: February 25, 2005

By: _____

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